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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MULLIS, JEFFREY C	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,233	DOLLASE ET AL.	
	Examiner	Art Unit	
	Jeffrey C. Mullis	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11* is/are rejected.

7)☒ Claim(s) *9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

All remaining rejections follow.

With re to the characteristic that P(B) has a refractive index of greater than or equal to 1.43, Takashi, 20040249073 discloses in paragraph 87 that refractive index of a polymer can be derived from that of the monomers and that styrene, methyl methacrylate, n-butyl acrylate and butadiene have refractive indices of 1.595, 1.494, 1.463 and 1.518 respectively. Aoyama, (US 6,383,620) discloses in column 4, lines 35-39 that a wide range of polymers have refractive indices of 1.48 or greater and implies that fluorination is needed for lower refractive indices. Therefore it can reasonably be concluded that any non fluorinated alkyl acrylate polymer block would meet applicants limitation that refractive index is greater than or equal to 1.43.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “at least one layer” encompasses only one layer despite the fact that claim 1 from which claim 9 depends requires three layers in the “system” minimum (including the adhesive layer).

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 encompasses systems with less than the required number of layers in claim 1 and therefore does not further limit claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Everaerts et al. (US 2004/0202881).

The reference discloses pressure sensitive adhesives which include coupled diblock copolymers of polystyrene and polybutyl acrylate. Note Example 6 and Table 4 disclosing that run “6A” contains 2.7 diblock arms. Since a whole number of arms are coupled in each molecule at least some two arm coupled (i.e. linear triblock material) material would be present and a distribution of coupling would also imply some

uncoupled, (i.e. free diblock) material would be present. Example 6B would similarly be expected to contain some triblock copolymer. In any case note paragraph 108 for addition of diblock copolymer as additive to facilitate processabilty. Note that applicants specification discloses polystyrene terminal blocks in the examples and paragraph 30 of applicants published specification discloses that polybutyl acrylate (converted to isooctyl acrylate which presumably has a similar refractive index to butyl acrylate due to the similarity in structure) may be used as applicants "B" block. Applicants and patentees characteristics are therefore presumably inherently identical. While possibly the block copolymer of Example 6 alone does not have enough styrene to meet applicants' limitation that the adhesive has a refractive index of 1.52, note paragraph 190 where the block copolymers are mixed at a level of 50% with aromatic tackifiers (i.e. high refractive index materials).

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

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Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts, cited above and optionally Hill, IV et al., newly cited (US 6,551,439).

Everaerts discloses use of isobornyl acrylate in paragraph 70 and ethyl hexyl acrylate in paragraph 81 and discloses that some “A’ block monomer may be present in the “B” block (though admittedly not preferably).

Applicants elected species is not discloses and arguably applicants refractive index is not inherent in the adhesive of Evaerts and arguably no diblock copolymer is present in Everaerts Examples. However choice of applicants components from the reference would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results. As set out above, Everaerts discloses the adherences of two glass plates with their adhesive for testing purposes. Therefore it would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to adhere two glass plates together as taught by Everaerts for testing purposes absent any showing of surprising or unexpected results.

Hill discloses that adherence of clear labels to clear containers is very desirable to consumers at column 1, lines 40-45. Hence it would have been obvious to a practitioner having an ordinary skill in the art a the time of the invention to adhere two transparent materials together using the adhesive of Everaerts as taught by Hill motivated by the disclosure of the primary reference of an adhesive that is to be used as labelstock and by the disclosure of the secondary reference that adherence of labels

to transparent containers is especially desirable absent any showing of surprising or unexpected results.

Applicant's arguments filed 3-23-09 have been fully considered but they are not persuasive.

Evaerts et al. disclose that the materials of their examples were tested by application to a “glass test plate” and “glass or polyethylene substrates”. Hence Evaerts meets the limitation of adherence to a first and second optically transparent substrate in that glass in transparent. The remaini9ng features of applicants claims are taught as set out in the above rejections.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

5-17-09

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796